



AUG 6 2001

In re

:
:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 1 and 32 of the morning section of the Registration Examination held on October 18, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 68. On January 26, 2001, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32.

The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of the Office of Patent Legal Administration.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the Official Gazette. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a

statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions.

Where the terms “USPTO” or “Office” are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning questions 1 and 23. Petitioner's arguments for these questions are addressed individually below.

Morning question 1 reads as follows:

1. Regarding the specification of a nonprovisional patent application, which of the following practices is in accordance with proper USPTO practice and procedure?

- (A) The specification may include graphical illustrations or flowcharts.
- (B) The specification may include tables and chemical formulas.
- (C) The specification may include hyperlinks or other forms of browser-executable code embedded in the text.
- (D) The specification must begin with one or more claims.
- (E) The specification may include a reservation for a future application of subject matter disclosed but not claimed in the application.

The model answer is choice B.

MPEP § 608.01, subsection “Illustrations In the Specification.” 37 C.F.R. § 1.58(a) permits tables and chemical formulas in the specification in lieu of formal drawings. (A) is incorrect. MPEP § 608.01, subsection “Illustrations In the Specification.” Graphical illustrations, diagrammatic views, flowcharts, and diagrams in the descriptive portion of the specification do not come within the purview of 37 C.F.R. § 1.58(a). The examiner should object to such descriptive illustrations in the specification and request formal drawings in accordance with 37 C.F.R. § 1.81 when an application contains graphs in the specification. (C) is incorrect. MPEP § 608.01, subsection “Hyperlinks And Other Forms Of Browser-Executable Code In The Specification.” USPTO policy does not permit the USPTO to link to any commercial sites since the USPTO exercises no control over the organization, views, or accuracy of the information contained on these outside sites. (D) is incorrect. 37 C.F.R. § 1.75(a). The specification must conclude with one or more claims. (E) is incorrect. 37 C.F.R. § 1.79. A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application.

Petitioner argues that answer (A) is correct along with the answer (B). Petitioner contends that the specification may include graphical illustrations or flowcharts because MPEP 608.01(a), under sections Arrangement of the Specification and Content of Specification, lists drawings (subsection k) as one of the elements.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that specification may include graphical illustrations or flowcharts, graphical illustrations or flowcharts should be submitted as drawings, not in a specification. The section of the MPEP that the petitioner cited does not states that the specification may include graphical illustrations or flowcharts, while 37 CFR 1.58(a) specifically set forth that “[t]he specification, including the claims, may contain chemical and mathematical formulas, but **shall not contain drawings or flow diagrams.**” (Emphasis added.) Accordingly, model answer (B) is correct and petitioner’s answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 23 reads as follows:

23. Mitch and Mac are named inventors on an international application that is filed in the USPTO Receiving Office, and designates the United States of America. Mac now indicates that he will not sign the Request for the international application. Mitch wishes to proceed with the Request and seeks the advice of their patent agent. Which of the following answers accords with the provisions of the Patent Cooperation Treaty?

- (A) Mitch's agent should sign the Request and accompany it with a statement indicating why it is believed that Mac refuses to proceed with the Request.
- (B) Mitch should sign the request for himself and also sign on behalf of Mac.
- (C) Mitch should sign the request and seek a court order to obtain Mac's signature.
- (D) Mitch should sign the Request and accompany it with a statement providing a satisfactory explanation for the lack of Mac's signature.
- (E) Mitch should sign the Request and Mitch's agent should sign on behalf of Mac, since he continues to represent Mac.

The model answer is selection D.

The advice is consistent with 37 C.F.R. § 1.425. (A), (B), (C), and (E) are wrong because the advice provided is not consistent with 37 C.F.R. § 1.425. MPEP § 1820, p.1800-16.

Petitioner argues that answer (A) is correct because the statement is consistent with MPEP 1820. Petitioner contends that according to the MPEP, the request may be signed by an agent on behalf of all or only some of the.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that Mitch's agent can sign the request, Mitch's agent cannot sign the request for Mac because he or she is not Mac's agent. The section "Signature of

Applicant or Agent” in MPEP 1820 set forth that “[t]he international application may be signed by an agent, but in that case the agent **must be appointed as such by the applicant in a separate power of attorney signed by the applicant.**” In absence of a power of attorney signed by Mac appointing Mitch’s agent, Mitch’s agent cannot sign on behalf of Mac. Therefore, answer (A) is incorrect and the model answer (D) is correct.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

ORDER

For the reasons given above, no point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above the printed name and title.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy